

**REMARKS**

**Formal Matters**

Claims 123-130 are pending.

The claims are not amended.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

**Rejection of claims under 35 U.S.C. §112, first paragraph**

Claims 123-130 are rejected for failing to comply with the enablement requirement of 35 U.S.C. §112, first paragraph. The Applicants respectfully traverse this rejection.

The Office Action states that the subject matter of the rejected claims could not be practiced without undue experimentation. The foundation of this rejection is the Examiner's opinion that one of skill in the art would not be able to use SEQ ID NO:972 as a cancer diagnostic.

In response, the Examiner is respectfully referred to paragraph 18 of the expert declaration by Dr. Christopher R. Somerville filed in the instant case on September 27, 2002 (the "Somerville Declaration"), in which Dr. Somerville unequivocally states that polynucleotides containing SEQ ID NO:972 can serve as probes in cancer diagnostics. For the Examiner's convenience, paragraph 18 of the Somerville Declaration is reproduced below with a relevant statement underlined.

18. When read in conjunction with the '292 specification, it is my unequivocal opinion that, a Skilled Person would find that the '292 specification describes polynucleotides fully representative of the genus of polynucleotides of the Invention since
- a) the Skilled Person would recognize disclosure of SEQ ID NO:972 as fully representative of the genus of the Invention since it is a complete disclosure of the common structural feature (i.e., at least 150 contiguous nucleotides of SEQ ID NO:972) of the Inventions; and
  - b) the Skilled Person would recognize the vector containing a cDNA containing the sequence of SEQ ID NO:972 and deposited with the A.T.C.C. is an example of a polynucleotide containing SEQ ID NO:972 having flanking sequences and as being fully representative of large polynucleotides that can serve as probes or starting materials for probes in cancer diagnostics.

According to MPEP § 716.01(c).III and current law<sup>1</sup>, the Office is required to consider an expert declaration as probative evidence of how one skilled in the art would have viewed the claimed subject matter. As such, Dr. Somerville's opinion cannot be ignored simply because it differs from the Examiner's opinion.

The Examiner is invited to provide an affidavit under 37 C.F.R. § 1.104(d)(2) in support of the assertions made. The Applicants submit that Dr. Somerville's declaration outweighs the Examiner's unsubstantiated assertions and, as such, this rejection should be withdrawn.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

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<sup>1</sup> *In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d (BNA) 1578, 1583 (Fed. Cir. 1996) (holding patent examiner erred in viewing declaration of applicant's expert as opinion evidence addressing question of law rather than question of fact)

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

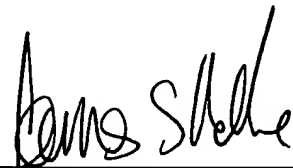
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number 2300-1487.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: \_\_\_\_\_

April 11, 2006

By: \_\_\_\_\_



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